

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD J. JULIEN

Appeal No. 97-1475
Application 08/069,544 ¹

ON BRIEF

Before MEISTER, FRANKFORT and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 11 through 30 as amended subsequent to the final rejection in papers filed October 30, 1995, February 28, 1996, April 23, 1996 and September 9, 1996 (Paper Nos. 10, 19, 23

¹ Application for patent filed June 1, 1993.

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and 26). Claims 11 through 30 are all of the claims remaining in this application. Claims 1 through 10 have been canceled.

Appellant's invention relates to a method of releasably securing a hasp (claim 11), a method of locking (claims 21 and 25), and a method of preventing access to an automobile steering column ignition lock (claim 18). As explained on page 2 of the specification, in the "Summary of the Invention," it was appellant's intention to

Provide a lock that cannot be cut or broken by ordinary tools.

Another object of the invention is to provide a method of securing valuable assets such that they are more secure from theft by thieves using ordinary tools.

Yet another object of the invention is to provide a lock that offers real protection against theft by being resistant to every known common form of breaking or cutting heretofore used to defeat locks.

A further object of the invention is to provide an automobile ignition lock cover that effectively deters auto theft.

Another object of the invention is to provide a padlock that can be made smaller than conventional padlocks and which is light weight, corrosion resistant, is highly resistant to breaking, cutting, and even burning with a torch.

These and other objects of the invention are attained in a lock having a shackle and a body for securing across

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the ends of the shackle with a latching device that can be released by a key or by a combination. The shackle and the catch of the latch are made of a shape memory alloy such as Nitinol. Another embodiment includes a cover that can be placed over the ignition lock of a vehicle and secured in place when the vehicle is left unattended. The cover is hardened steel and the lock which secures it in place includes a shackle and a catch made of a shape memory alloy, preferably Nitinol, that is impossible to break or cut with ordinary tools.

On pages 4 through 6 of the specification, it is emphasized why the shackle (30) and the catch or locking pin (46) of the lock are to be made of Nitinol, for example, "Type 55 Nitinol." These pages of the specification also discuss advantageous properties or characteristics of Nitinol that make the lock components made of such material "uniquely resistant to attack by thieves and other persons intent on cutting or breaking the lock" (specification, page 5).

Claims 11, 18, 21 and 25 are representative of the subject matter on appeal and a copy of those claims may be found in the Appendix to the reply brief (Paper No. 27, filed September 9, 1996).

The prior art references of record relied upon by the examiner are:

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Dutton	2,407,406	Sep. 10, 1946
Goldstein	4,561,272	Dec. 31, 1985
Freeman	4,598,562	Jul. 08, 1986
Dalby	4,753,465	Jun. 28, 1988

THE REJECTIONS ²

Claims 11 through 30 stand rejected under 35 U.S.C. § 112, first paragraph, as being directed to a specification which, as originally filed, does not support the invention as now claimed. According to the examiner (answer, page 6), the recitation in claims 11, 18, 21 and 25 of "primarily solid monolithic" Nitinol has no support in the original specification.

Claims 11, 12 and 21 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dutton in view of Goldstein.

Claims 13 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Dutton in view of Goldstein as applied to claims 11 and 12 above, and further in view of Dalby.

² As indicated in the supplemental examiner's answer mailed November 25, 1996 (Paper No. 28), the rejection of claim 24 under 35 U.S.C. § 112, second paragraph, as stated in the final rejection and examiner's answer has been overcome. In addition, it is indicated that the rejection of claim 17 under 35 U.S.C. § 112, second paragraph, and the objection to claim 18 set forth on pages 6 and 7 of the examiner's answer have been obviated by the amendment filed September 9, 1996.

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Claims 18 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Freeman in view of Goldstein.

Claims 25, 28 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goldstein in view of Dutton.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goldstein in view of Dutton as applied to claim 25 above, and further in view of Freeman.

Claim 29 stands rejected under 35 U.S.C. § 103 as being unpatentable over Goldstein in view of Dutton and Dalby.

Rather than reiterate the examiner's statement of each of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant, we refer to the examiner's answer (Paper No. 25) and supplemental examiner's answer (Paper No. 28), and appellant's brief (Paper No. 24) and reply brief (Paper No. 27) for the full exposition thereof.

OPINION

In arriving at our decision in this appeal, we have carefully considered appellant's specification and claims (both as

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originally filed and as amended), the applied references, and the respective positions of the examiner and appellant regarding the various issues before us on appeal. As a consequence of our review, we have made the determinations which follow.

Turning first to the examiner's rejection of claims 11 through 30 under 35 U.S.C. § 112, first paragraph, we note that the test for determining compliance with the written description requirement of the first paragraph of §112 is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In this regard, it is important to additionally understand that the claimed subject matter does not have to be expressed in ipsis verbis in the specification in order to satisfy the description requirement of §112 (See In re Wertheim 541 F.2d, 257, 265, 191 USPQ 90, 98 (CCPA 1976)) and that, under appropriate circumstances, the original drawings may also provide the required "written description of the invention." See Vas-Cath Inc. v. Mahurkar, 935, F.2d, 1555, 1564, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991); In re Wolfensperger, 302 F.2d, 950, 956, 133 USPQ 537, 543 (CCPA 1962).

With this as our background, we turn to the examiner's objection to the recitation in claim 11 of "primarily monolithic Nitinol," in claims 18 and 25 of "primarily solid monolithic Nitinol," and in claim 21 the recitation that the lock shackle is made "primarily of solid monolithic Nitinol." The above language was added to the enumerated independent claims subsequent to the final rejection (see Paper Nos. 10, 19, 23 and 26). In Paper No. 19, the following paragraph was also added to page 6 of the specification,

As shown in Figs 1-3, the shackle is made of primarily solid monolithic Nitinol. The term "primarily solid monolithic Nitinol shackle" is intended to mean that the shackle is a single homogeneous undifferentiated material throughout, and its primary protective strength is provided by the solid Nitinol, although the shackle could also be painted or have some other decorative finish or non-structural elements common in locks applied.

In the examiner's view, these additions to the specification and claims constitute new matter. While the examiner is correct in observing that appellant's original specification does not expressly use the terminology "primarily solid monolithic Nitinol," we must agree with appellant that the person of ordinary skill in the art at the time of filing of the

application would have readily recognized from the depiction in Figures 1 and 3 of the shackle (30) and locking pin (46), and from the description in the original specification, that these elements of the lock therein were made completely of Nitinol, for example, of Type 55 Nitinol, or in appellant's terms that the shackle and locking pin are made of "a single homogeneous undifferentiated material throughout," with that material being "solid monolithic Nitinol." Thus, when we give proper consideration to the entire disclosure of appellant's application as originally filed, as such would be viewed by the person of ordinary skill in the art, we find that there is a reasonable basis to conclude that the disclosure would have conveyed to the artisan that the inventor had possession of the presently claimed subject matter of claims 11 through 30 on appeal at the time of filing of the application. The examiner's rejection of these claims under 35 U.S.C. § 112, first paragraph, as lacking support in the originally filed disclosure will therefore not be sustained.

It follows from our determination above, regarding the examiner's rejection under 35 U.S.C. § 112, first paragraph,

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that we do not agree with the examiner's characterization of the amendment to page 6 of the specification (made in Paper No. 19) as being new matter. In our view, the person of ordinary skill in the art would have reasonably recognized from the originally filed disclosure that the shackle and locking pin or catch of the padlock described therein were to be made completely of Nitinol, so as to take advantage of the properties thereof as set forth on pages 4 through 6 of the specification. In our opinion, the questioned amendments merely clarify that which was already reasonably apparent from the originally filed drawings and specification of appellant's application. Thus, these amendments do not constitute new matter and should be allowed to remain in the application.

Next, we turn to the examiner's prior art rejections, and proceed by first addressing the rejection of claims 11, 12 and 21 through 24 under 35 U.S.C. § 103 as being unpatentable over Dutton in view of Goldstein. According to the examiner, Dutton teaches the basic method of using a padlock shackle (28) to lock a hasp and staple (62, 64), while Goldstein clearly teaches a Nitinol shackle. The examiner concludes that it would have been

obvious to one of ordinary skill in the art at the time of appellant's invention to modify the method of Dutton by providing a padlock shackle therein made of a Nitinol material.

In response to appellant's arguments that Goldstein teaches a composite shackle (e.g., at column 2, lines 27-33 thereof) and does not teach or suggest a "primarily monolithic Nitinol" shackle as in independent claim 11 on appeal, or a shackle made "primarily of solid monolithic Nitinol" as in independent claim 21 on appeal, the examiner has made the assertions (answer, page 10) that 1) the Nitinol composition as disclosed in Goldstein is "clearly anticipatory with respect to the claimed Nitinol shackle", 2) the instant claims do not preclude the use of a matrix like that of Goldstein, and 3) the arguments made by appellant are "moot since, the definition and supporting added language is new matter."

We begin with the examiner's last assertion first, noting that the Manual of Patent Examining Procedure (MPEP) in section 2163.06 (Rev. 3, July 1997), at page 2100-141, makes clear that the examiner must still consider the subject matter added to the claim or claims in making rejections based on prior art since the new matter rejection may be overcome by appellant. See also,

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section 2143.03 of the MPEP, last paragraph, wherein it is expressly noted that when evaluating claims for obviousness under 35 U.S.C. § 103, all limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e., new matter). In addition, see Ex parte Pearson, 230 USPQ 711, 172 (Bd. App. 1985) and Ex parte Grasselli, 231 USPQ 393, 394 (Bd. App. 1983).

Thus, it is clear that appellant's arguments regarding the limitations of claims 11, 18, 21 and 25 concerning the newly added language that the shackle is of "primarily monolithic Nitinol" or "primarily solid monolithic Nitinol" are not moot as the examiner urges. Moreover, when these limitations of the claims on appeal are considered and given proper weight, it is clear that the composite structure of the shackle of Goldstein is not anticipatory of the claimed monolithic Nitinol shackle as the examiner believes, and that contrary to the examiner's assertions the language of the claims on appeal when properly construed does in fact exclude the use of a composite matrix material of tungsten carbide particles and nickel-titanium alloy like that taught in Goldstein. For these reasons, we will not sustain the

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examiner's rejection of claims 11, 12 and 21 through 24 under 35 U.S.C. § 103 as being unpatentable over Dutton in view of Goldstein.

Turning now to the examiner's rejection of claims 13 through 17 under 35 U.S.C. § 103, we note that the addition of the teachings of Dalby to those of Dutton and Goldstein does nothing to supply that which we have indicated above to be lacking in the combination of Dutton and Goldstein. Moreover, as urged by appellant, it is highly unlikely that one of ordinary skill in the art would have been led to modify the padlock of Dutton based on the very specialized and diverse teachings of the space craft launch lock mechanism of Dalby, absent appellant's own teachings and the application by the examiner of impermissible hindsight. Accordingly, the examiner's rejection of claims 13 through 17 under 35 U.S.C. § 103 will also not be sustained.

As for the examiner's rejection of claims 18 through 20 under 35 U.S.C. § 103 based on the combined teachings of Freeman and Goldstein, we note that, in our opinion, neither of these references teaches or suggests a method of "preventing access to an automobile steering column ignition lock" as set forth in

independent claim 18 on appeal. Not only is there no teaching of locking the cover of claim 18 in a closed position with a lock "having a primarily solid monolithic Nitinol shackle" as required in claim 18, but, as is clear from a reading of Freeman (at column 2, lines 28-32), there is also no teaching in these references of "covering said ignition lock with a cover" so as to prevent access thereto as required in appellant's claim 18. Freeman expressly indicates that the user therein can "freely manipulate the ignition key in the ignition key housing without interference from the jacket." Thus, the examiner's rejection of method claims 18 through 20 under 35 U.S.C. § 103 will not be sustained.

Regarding the rejection of claims 25 through 30 under 35 U.S.C. § 103 utilizing Goldstein as the primary reference, we again note that neither Goldstein nor Dutton teaches or suggests a lock shackle that is made of "primarily solid monolithic Nitinol," as required in claim 25 on appeal. As for the recitations of dependent claim 27, we again point to the deficiencies of Freeman as noted above, observing that Freeman does not teach or suggest a cover member "covering an automotive key slot of a motor vehicle ignition lock tumbler," or an

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arrangement wherein the lock which secures such a cover in position "must be removed to gain access to said ignition lock tumbler," as set forth in appellant's method claim 27 on appeal. In addition, our comments supra with regard to Dalby are again pertinent here. For these reasons, we will not sustain the examiner's rejections of claims 25 through 30 under 35 U.S.C. § 103.

As is apparent from the foregoing, the examiner's rejection of claims 11 through 30 under 35 U.S.C. § 112, first paragraph has been reversed, as has each of the examiner's rejections of claims 11 through 30 under 35 U.S.C. § 103.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
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